

## **REMARKS**

This application has been reviewed in light of the Office Action mailed May 11, 2006.

Reconsideration of this application in view of the below remarks is respectfully requested.

Claims 1, 3 – 7 and 9 – 15 are pending in the application with Claims 1, 7 and 13 – 15 being in independent form. By the present amendment, Claims 1, 7, 13, 14 and 15 are amended and Claims 3 and 9 are canceled. No new subject matter is introduced into the disclosure by way of the present amendment.

Initially, Applicant thank the Examiner for indicating that Claims 3 and 9 contain patentably distinct subject matter and thus would be allowable if rewritten in independent form including all the limitations recited in the base claim and any intervening claims.

### **I. Rejection of Claim 14 Under 35 U.S.C. § 101**

Claim 14 is rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Specifically, the Office Action states that the recited “computer data signal embedded in a carrier wave” does not fall into one of the four statutory classes of 35 U.S.C. § 101 because a signal is not a process, a machine, a composition of matter, or a manufacture.

However, a computer data signal embedded in a carrier wave is in fact a manufacture of man, since without the necessary ingenuity of man the carrier wave would not contain such a data signal in nature, the data signal have particular properties used to encode instructions. Therefore, such a signal is manufactured under the definition of “manufacture” commonly understood and provided in Webster’s Dictionary as: “...the act or process of producing something.”

The Supreme Court noted in *Diamond v. Chakrabarty* (447 U.S. 303 (1980)) that in the Patent Act of 1952 Congress intended statutory subject matter to "include anything under the sun that is made by man" based on the legislative history. (See: S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H. R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952)). While in the specific case of *Diamond v. Chakrabarty*, the invention in question is a genetically engineered oil-eating bacterium, Congress' intent of including anything made by man clearly applies to the invention of Claim 14 as well.

Further, in accordance with the Manual of Patent Examining Procedure a signal claim directed to a practical application of electromagnetic energy is statutory. (See: MPEP § 2106(B)(1)(c) (8th ed., August 2005)).

In consideration of the above-provided reasoning, Applicant respectfully believes that Claim 14 is directed to statutory subject matter. Accordingly Applicant respectfully traverses the rejection with respect to Claim 14 under 35 U.S.C. § 101.

## **II. Rejection of Claims 1, 4 – 7 and 10 – 15**

Claims 1, 4 – 7 and 10 – 15 are rejected under non-statutory double patenting as allegedly obvious over Claims 1 – 3 of U.S. Patent No. 6,798,893 issued to Tanaka. Further, the Examiner has rejected Claims 1, 4 – 7 and 10 – 15 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,208,745 issued to Florencio et al.

In response, Claims 1, 7, 13, 14 and 15 have been amended to include the allowable subject matter recited in Claim 3 and subsequently, Claims 3 and 9 have been canceled. Therefore, for at least the reasons provided in the present Office Action regarding the allowability of Claims 3 and 9, Claims 1, 4 – 7 and 10 – 15 are believed to be patentably distinct

and allowable over the cited prior art references. Accordingly, Applicant respectfully request withdrawal of the rejections with respect to Claims 1, 4 – 7 and 10 – 15.

## CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 1, 4 – 7 and 10 – 15 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



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